

Remarks

Originally filed claims 1, 15, and 33 have been amended to emphasize that the step of passing the initial communication to be modified to become a final communication is optional. New independent claims 34 and 35 directed to other aspects of the invention also include such novel and non-obvious step so that all claims have such limitation.

Basis for the amendment is found, for example, in the paragraph extending from page 10, line 36 to page 11 line 8 of the specification of the present application which includes the statement that stated that, "optionally, in some circumstances, the whole of the message cannot be compiled automatically by the communications package." (This may occur if for example contract terms have to be inserted into an agreement.)

The linguistic style of Claim 1 has also been amended.

Claim 16 has also been amended to incorporate the limitation of claim 15, consequently canceled.

Notwithstanding the amendment to claims 1,15 and 33, it is pointed out that the optional nature of the step of modifying the communication was implicit in claims 1,2 and 33, as originally filed, in particular, according to the wording:

"determining that the initial communication is to be modified to become a final communication;

modifying the initial communication in response to a determination that the initial communication is to be modified to become a final communication;"

Thus, the amendment should, at least in that respect, be considered merely one of making explicit that which was previously implicit in the claim.

Claims 29-32 have been canceled to avoid additional claims fees and without prejudice to reinstatement in the present or a continuing application.

In the office action, the examiner has rejected the originally filed claims under 35 U.S.C. 103 as unpatentable over US 6505236 (Pollack) in view of US 6438584 (Powers).

In contending the examiner's position, it is first pointed out that the primary reference, Powers discloses an e-mail attachment storage system. As shown in

the flow chart of figure 2, an e-mail containing an attachment is received by a data store. The attachment is detached from the e-mail and stored in the data store with a specific address. The e-mail is then forwarded to an intended recipient but without the attachment which remains stored in the data store. The e-mail is sent with the address of the attachment so that a user can download the attachment at a later, convenient time.

It is apparent that Pollack does not teach the provision of a template along the lines of the present invention - a template which includes embedded logic which determines whether or not selected portions of data or text are to be enclosed in an automatic communication. Moreover, Pollack does not suggest or disclose a step for determining whether an initial communication is required to be modified before becoming a final communication.

Thus, the teaching of Pollack, properly considered as a whole, is not concerned with the generation of automatic communications in response to some trigger or event, but merely concerned with reducing overheads for data storage and the efficient communication of electronic correspondence between users. (In this respect, the approach taught by Pollack has been somewhat superseded by the development of wide bandwidth communications.)

Thus, the Pollack teaching is concerned, not with the generation of a new, more complex document, but with breaking up an existing document for reasons of storage efficiency, an approach which is not merely distant but, in a sense, opposite from the approach taught by the claimed invention.

As such, the Pollack teaching as a whole addresses a different and wholly dissimilar, in a sense opposite, technical problem to that of the present application and lies in a different technical field.

Thus, the man of ordinary skill would be prejudiced against considering the teaching of Pollack when seeking a solution to the problem of compiling or synthesizing documents electronically.

The teaching of the secondary reference Powers, is concerned with the generation of written correspondence from text internet e-mail messages. As perhaps best seen in Figure 5, Powers teaches that an e-mail can be imported into a graphical

user interface for amendment and changes. The interface includes options to change the format of the generated letter, such options may include: format information, registered signature and channel with which the letter is to be delivered. The data such as address and format of the letter appear to be contained within a data store held either on the computer or remotely on a server.

In contrast to the limitation of the claimed invention that modifying the messages is optional, (see current specification, page 10, lines 9 -17), Powers teaches as a whole that the review step is mandatory, i.e. it is compulsory that every letter to be sent out must go through the review procedure and be accepted or changed. This requires input from a user and could therefore be subject to mistakes and is also time consuming and inefficient.

In conclusion, it is submitted that a person of ordinary skill in the technical field of the invention would be prejudiced against attempting to combine the teachings of the primary and secondary references because they lie in differing technical fields and have contrasting objectives - to break down a message in a single document and to synthesize a message in a document, respectively

Even if a person of ordinary skill in the technical field of the invention were to attempt to combine the respective teachings of the two referenced document, it would not result in the claimed invention and likely involve aspects of a system in which attachments are stripped out and received by a data store rather than aspects in which automatic communications are optionally modified before a final communication is issued for a recipient.

Accordingly, it is submitted that the claims define patentable subject matter and favorable reconsideration of the application is requested.

Respectfully submitted,
/Robert W.J. Usher/
Robert W.J. Usher
Customer 04518; reg 30932
212 633 1076